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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/921,258

08/01/2001

James Allen Clark

2705-186

7013

20575

7590

10/31/2005

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EXAMINER

BUI, KIEU OANH T

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/921,258	<b>Applicant(s)</b> CLARK, JAMES ALLEN	
	<b>Examiner</b> KIEU-OANH T. BUI	<b>Art Unit</b> 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, and 20-25, drawn to a network termination unit, classified in class 725, subclass 110.
  - II. Claims 10-14, drawn to a video content server, classified in class 725, subclass 114.
  - III. Claims 15-19 and 31-33, drawn to an article contains machine readable code and a corresponding method, classified in class 717, subclass 136.
2. Inventions I, and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because group I clearly refers to a network termination unit. The subcombinations has separate utilities such as the video content server provides the content to the terminal unit. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as the machine-readable code is programmed in the machine to detect the pause of the user of the terminal unit. See MPEP § 806.05(d).

Art Unit: 2611

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II & III, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Ms. Julie Reed on 10/18/05 a provisional election was made with traverse to prosecute the invention of **Group I, claims 1-9 and 20-25**.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-19 and 26-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

5. Claims 1-9, and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenberg et al. (U.S. Patent Pub No. US2002/0100041 A1).

Regarding claim 1, Rosenberg discloses a network termination unit (Fig. 1a, with a replay unit 104), comprising: a detector operable to receive command signals from a user, wherein the command signals include a pause signal (Fig. 1a, the user has a remote control for providing user input command signals to pause a displaying program or content (Fig. 1a, item 130, and pages 2-3, par. 0033 to 0036); a controller operable to control access to content (a processor does this function, refer to col. 2/par. 0033); a timer operable to time a pause interval initiated reception of pause signal (Fig. 10, and page 8/par. 0119 for a timer for the pause intervals); and a source of alternate content, operable to provide the controller with alternative content when the pause interval reaches a predetermined length of time (the amount of time before an ad or other content to be displayed can be user defined as the user hits the pause for pausing the currently viewing program/content, refer to page 8, par. 0016-0017).

Art Unit: 2611

As for claim 2, Rosenberg discloses the network termination unit further comprises a set top box (page 2/par. 0031).

Regarding claim 3, Rosenberg inherently disclose “a cable modem” in the network terminal unit; Rosenberg suggests that the video replay system is not limited to interactive TV, set top applications, as well as high definition TV content, content broadcast over the Internet either wired or wireless (page 2/par. 0031-0034). It inherently suggests the video replay system further includes a cable modem for accessing to the Internet for high bandwidth downloading

As for claims 4-6, Rosenber discloses wherein the controller is a processor, a microcontroller, or a central processing unit (page 2/par. 0033, a processor is same as microcontroller or a CPU).

As for claim 7, Rosenberg further discloses wherein the source of alternative content is located in a memory located in the network termination unit (page 2/par. 0033 & page 3/0043 for a storage such as a hard drive for storing alternative content such as programs, ads and programming guides).

As for claim 8, Rosenberg further discloses wherein the source of alternative content is a connection to a remote server (Fig. 2/remote server 102, page 3/par. 0044).

As for claim 9, Rosenberg further discloses wherein the source of alternative content is programmable by the viewer (page 8/par. 0116 to par. 0119 and Fig. 10 for the user can set up which content to be displaying during the pause intervals).

As for claims 20-25, these claims with same limitations addressed earlier are rejected for the reasons given in the scope of claims 1-2 and 4-9 as disclosed in details above.

Art Unit: 2611

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Plotnick et al and So et al (PTO 892 attached) disclose systems related to providing alternative contents during intermission or pause intervals.

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to PTO New Central Fax number:**

(571) 273-8300, (for Technology Center 2600 only)

*Hand deliveries must be made to Customer Service Window,  
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to "Krista" Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

Art Unit: 2611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K. Bui', with a long horizontal flourish extending to the right.

Kieu-Oanh Bui  
Primary Examiner  
Art Unit 2611

KB

Oct. 19, 2005